

In re: Navarro Acevedo *et al.*  
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#### REMARKS

Claims 1-38 are pending in the application. Claims 18-38 have been cancelled as being drawn to non-elected inventions. Applicants expressly reserve the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the cancelled claims. Claims 1, 5, 9, and 13 (and thus their respective dependent claims) have been amended. Support for the amendments can be found in the specification as filed and is discussed in detail in this paper. No new matter has been added by way of amendment. Reexamination and reconsideration of the claims are respectfully requested.

#### Title

The Examiner has objected to the title of the invention as still not being descriptive of the instant invention. Applicants have amended the title to "A Pathogen-Activated Plant Promoter And Methods Of Using It In Expressing Heterologous Nucleic Acids In Transformed Plants," in order to more clearly indicate the invention to which the claims are directed. This amendment is shown in the previous section entitled "Amendments to the Specification," beginning on page 2 of the instant response. No new matter is added by way of the amendment to the title.

#### Abstract

The Examiner has objected to the abstract of the invention as still not being descriptive of the instant invention. Applicants have amended the abstract as shown in the previous section entitled "Amendments to the Specification," beginning on page 2 of the instant response. Applicants assert that the new abstract is clearly indicative of the invention to which the claims are directed. No new matter is added by way of the amendment to the abstract.

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The Rejection of Claims Under 35 USC §112, First Paragraph, Should be Withdrawn  
*Enablement*

The Examiner has rejected claims 1-17 under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants respectfully disagree.

The Examiner states that the instant specification fails to provide evidence that SEQ ID NO: 3 functions as a promoter and that it fails to teach any promoter that would hybridize to SEQ ID NO: 3, or the structural features of any such promoter.

Applicants point out that the identification of promoters associated with specific and identified genes has become routine to those of skill in the art, and furthermore that one of skill in the art would clearly recognize that SEQ ID NO: 3 has the elements described on pages 27 and 28 of the specification as originally filed. Specifically, the promoter of the instant invention has many of the required and/or expected promoter elements, including a TATA box (page 27, lines 20-21); an ACGT box, commonly found in plant promoters, which is related to the G-box (page 27, lines 22-28); a CAAT box (page 27 line 29-30); 35S core enhancer-like elements (page 28, lines 1-3); an L-box element (page 28, lines 4-7); palindromic sequences (page 28, lines 8-13); and a GCC box (page 28, line 15-18).

Although Applicants earnestly believe the hybridization claims to be enabled as presented, in the interests of furthering prosecution, Applicants have amended the claims to remove reference to hybridization.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-17 under 35 USC §112 for lack of enablement.

*Written Description*

The Examiner has rejected claims 1-17 under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as

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to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner states that the specification does not describe the structural features of any promoters that hybridize to SEQ ID NO: 3. As previously noted in this paper, in order to further prosecution, Applicants have amended the claims to remove reference to hybridization, thereby obviating the rejection.

Accordingly, Applicants request that the rejection of claims 1-17 under 35 USC §112, first paragraph, be withdrawn.

The Rejection of Claims Under 35 USC §112, Second Paragraph, Should be Withdrawn

The Examiner has rejected claims 1-17 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

The Examiner specifically states that part (c) of claims 1, 5, 9, and 13 is indefinite in its recitation of "stringent conditions" because the hybridization and wash times are not recited. As previously noted in this paper, in order to further prosecution, Applicants have amended the claims to remove reference to hybridization, thereby obviating the rejection.

Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1-17 under 35 USC §112, second paragraph.

The Rejection of Claims Under 35 USC §102 Should be Withdrawn

The Examiner has rejected claims 1-5, 8-9, 12-13 and 16 under 35 USC §102(b) as being anticipated by Stalker *et al.* (WO 98/30698). Stalker *et al.* teach a cotton promoter comprising 41 contiguous nucleotides of SEQ ID NO:3. Stalker *et al.* do not teach the sequence set forth in SEQ ID NO:3. Accordingly, in view of the claim amendments removing reference to promoters hybridizing to SEQ ID NO: 3 under stringent conditions, Applicants assert that the Stalker *et al.* reference does not apply as 35 USC §102(b) art.

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The Examiner has rejected claims 1-5, 8-9, 12-13 and 16-17 under 35 USC §102(e) as being anticipated by Perera *et al.* (US Patent 6,462,257). Perera *et al.* teach nucleic acids that each comprise 37 contiguous nucleotides of SEQ ID NO:3. Perera *et al.* do not teach the sequence set forth in SEQ ID NO:3. Accordingly, in view of the claim amendments removing reference to promoters hybridizing to SEQ ID NO: 3 under stringent conditions, Applicants assert that the Perera *et al.* reference does not apply as 35 USC §102(e) art.

In view of the preceding remarks and claim amendments, Applicants respectfully request withdrawal of the rejection of the claims under 35 USC §102.

The Rejection of Claims Under 35 USC §103 Should be Withdrawn

The Examiner has rejected claims 1-17 under 35 USC §103(a) as being unpatentable over Perera *et al.* (US Patent 6,462,257, filed 1 June 1999) in view of Gordon-Kamm *et al.* (1990, Plant Cell 2:603-618). Perera *et al.* teach nucleic acids that each comprise 37 contiguous nucleotides of SEQ ID NO:3. Perera *et al.* do not teach, disclose or suggest the sequence set forth in SEQ ID NO:3. Perera *et al.* also do not teach, disclose or suggest maize plants transformed with constructs comprising the nucleic acid of SEQ ID NO:3.

Gordon-Kamm *et al.* teach transformation of maize and production of seed from the transformed plants. Gordon-Kamm *et al.* do not teach, disclose or suggest the sequence set forth in SEQ ID NO:3. Gordon-Kamm *et al.* also do not teach, disclose or suggest maize plants transformed with constructs comprising the nucleic acid of SEQ ID NO:3.

In view of the claim amendments removing reference to promoters hybridizing to SEQ ID NO: 3 under stringent conditions, Applicants assert that the Perera *et al.* and Gordon-Kamm *et al.* references cannot be combined to motivate one of skill in the art to express a heterologous nucleic acid in a plant using the promoter of SEQ ID NO: 3.

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Accordingly, Applicants request the withdrawal of the rejections of claims 1-17 under 35 USC 103(a).

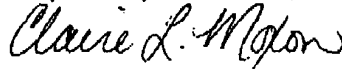
### CONCLUSION

In view of the above amendments and remarks, Applicants submit that the rejections of the claims under 35 USC §112, first and second paragraphs, 35 USC §102 and 35 USC §103 have been overcome. Applicants respectfully submit that this application, claims 1-17, is now in condition for allowance. Early notice to this effect is solicited.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject Application, the Examiner is invited to call the undersigned.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-1852.

Respectfully submitted,



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Agent for Applicant(s)

(See: LIMITED RECOGNITION  
UNDER 37 CFR § 10.9(b)  
SUBMITTED 6-17-2003)

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